

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 13, 2004 ("Office Action"). In the Office Action, Claims 1-39 are pending in the Application and the Examiner rejects Claims 1-39. Applicant notes with appreciation Examiner's acceptance of the drawings. Applicant has amended Claims 1, 5-7, 9-11, 14, 16, 20-21, 23-26, 29-32, 34-37, and 39. Applicant submits that no new matter has been added with these amendments. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Information Disclosure Statement

The Examiner states that the Information Disclosure Statement (IDS) filed by Applicant on December 29, 2000, fails to comply with 37 C.F.R. 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the office. Applicant submits that a PTO-1449 form listing the patents, publications, and other information was submitted in the December 29, 2000, filing. For the Examiner's convenience, Applicant has enclosed a copy of the previously submitted IDS and PTO-1449 form. Additionally, Applicant has included a copy of the date-stamped postcard indicating the submission of the IDS and PTO-1449 form. Applicant respectfully requests that the Examiner consider the cited references and provide the appropriate indication that they have been considered by initialing next to the references on the PTO-1449 form.

Applicant makes this response to the Office Action mailed May 13, 2004 only providing that the Examiner does not hereafter issue a Final Office Action relying on any art submitted with the December 29, 2000, Information Disclosure Statement but not considered in the May 13, 2004, Office Action. If the Examiner feels additional rejections based on this art are appropriate, Applicant respectfully requests that the Examiner issue a second new Office Action rather than a Final Office Action, to give Applicant a full and fair opportunity to respond to any new rejections based on this art that was timely submitted before the mailing of the first Office Action. Naturally, Applicant would also

respectfully request that the shortened statutory period for response to the new Office Action be restarted on the date such second new Office Action is mailed.

Section 102 Rejections

The Examiner rejects Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, and 36-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,983,273 issued to White et al. (“*White*”). For the following reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, and 36-37.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *White* does not disclose, either expressly or inherently, each and every element of the claims.

For example, independent Claim 1, as amended, recites *inter alia*:

. . . initiating a service request message by a first client to a first server, the service request message initiated after a call session has been established between the first client and a communication network . . . and delivering the requested service to the first client during the established call session . . .

Applicant respectfully submits that *White* does not disclose, teach, or suggest the above recited features. To the contrary, *White* merely discloses a “mobile mechanism of physical security” that may be associated with a user such that “the preferences and environment [are made] available to the user upon establishing a user session by way of the physical security device.” (Column 1, lines 46-52). As disclosed in *White*, the physical security device includes a SmartCard 9, which may include a plastic card with a memory chip 13 pre-programmed with identification information for uniquely identifying the SmartCard 9. (Column 4, lines 6-10). The SmartCard may be used in conjunction with an internet

terminal 10 such as a WebTV box that “includes hardware and software for providing the user with a graphical user interface, by which the user can access the WebTV network services, browse the Web, send e-mail, and otherwise access the Internet.” (Column 3, lines 57-61).

More specifically, the SmartCard allows “a user session to be initiated by someone other than the users associated with the particular the [sic] WebTV box 10.” (Column 8, lines 60-62). “[W]hen a user logs into the WebTV service using a SmartCard 9, identification information stored on the SmartCard 9 is used to initially access the customer database 540.” (Column 8, lines 63-65). “The log-in service 515 may search the customer database for a SmartCard ID 630 matching the identification information provided during log-in.” (Column 8, line 67 through Column 9, line 2). “Upon finding the appropriate customer record, the log-in service 515 can retrieve the customer ID 615 corresponding to the identification information.” (Column 9, lines 2-5). “[T]he association of a SmartCard 9 with a user account provides a mobile mechanism for accessing the account while maintaining physical security.” (Column 10, lines 15-17). Thus, the log-in process disclosed in *White* merely allows the initiation of an internet session using a standard login procedure for the authentication of the user of the SmartCard. In fact, *White* provides that “[i]f the identification information is not authenticated by the correct password, log-in will be denied and no user session will be established.” (Column 9, lines 62-65). Accordingly, Applicant respectfully submits that *White* does not disclose, teach, or suggest “initiating a service request message by a first client to a first server, the service request message initiated after a call session has been established between the first client and a communication network . . . and delivering the requested service to the first client during the established call session,” as recited in Applicant’s Claim 1.

For reasons similar to those discussed above with regard to Claim 1, Applicant believes that *White* does not disclose, teach, or suggest each and every limitation recited in Applicant’s independent Claims 14, 29, and 36. For example, Applicant submits that *White* does not disclose, teach, or suggest a client operable to “establish a call session between the client and a communication network” and “a second device operable to . . .

insert the requested service into the established call session,” as recited in Applicant’s Claim 14. As another example, Applicant submits that *White* does not disclose, teach, or suggest “initiating a service request message by a first client to a first server, the service request message initiated after a call session has been established between the first client and a communication network . . . and delivering the requested service to the first client during the established call session,” as recited in Applicant’s Claim 29. As still another example, Applicant submits that *White* does not disclose, teach, or suggest “means for initiating a service request message by a first client to a first server, the service request message initiated after a call session has been established between the first client and a communication network, the service request message including the first client identity and a requested service to be inserted into the established call session. . . and means for delivering the requested service to the first client during the established call session,” as recited in Applicant’s Claim 36. As discussed above, *White* merely discloses the use of a SmartCard security device to initiate an internet session using a standard login procedure for the authentication of the user of the SmartCard. Accordingly, Applicant submits that the above recited features are completely absent from the disclosure of *White*.

Claims 2-6 and 12 depend from independent Claim 1, which Applicant has shown above to be allowable. Claims 16-20, 22, and 27 depend from independent Claim 14, which Applicant has shown above to be allowable. Claims 30-31 and 37 depend from independent Claims 29 and 36, respectively, which Applicant has shown above to be allowable. Since Claims 16-20, 22, 27, 30-31, and 37 incorporate the limitations of their respective independent claims, Claims 16-20, 22, 27, 30-31, and 37 are allowable for at least this reason. Additionally, Applicant respectfully submits that Claims 16-20, 22, 27, 30-31, and 37 also recite features that are not disclosed, taught, or suggested in *White*. Because Applicant has shown the independent claims to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 16-20, 22, 27, 30-31, and 37. Applicant remains ready to do so if it becomes appropriate.

For at least these reasons Applicant respectfully requests reconsideration and allowance of Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, and 36-37.

Section 103 Rejections

The Examiner rejects Claims 7-11, 13, 15, 21, 23-26, 28, 32-35, and 38-39 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *White*, U.S. Patent No. 6,453,362 issued to Bittinger et al. ("*Bittinger*"), U.S. Patent No. 5,854,894 issued to Lancaster et al. ("*Lancaster*"), and U.S. Patent No. 6,122,631 issued to Barbec et al. ("*Barbec*").

Claims 7-11 and 13 depend from independent Claim 1, which Applicant has shown above to be allowable. Claims 15, 21, 23-26, and 28 depend from independent Claim 14, which Applicant has shown above to be allowable. Claims 32-35, 38, and 39 depend from independent Claim 36, which Applicant has shown above to be allowable. Since Claims 7-11, 13, 15, 21, 23-26, 28, 32-35, 38, and 39 incorporate the limitations of their respective independent claims, Claims 7-11, 13, 15, 21, 23-26, 28, 32-35, 38, and 39 are allowable for at least this reason. Additionally, Applicant respectfully submits that Claims 7-11, 13, 15, 21, 23-26, 28, 32-35, 38, and 39 also recite features that are not disclosed, taught, or suggested in *White*. Because Applicant has shown the independent claims to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 7-11, 13, 15, 21, 23-26, 28, 32-35, 38, and 39. Applicant remains ready to do so if it becomes appropriate.

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CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brad P. Williams, Attorney for Applicant, at the Examiner's convenience at (214) 953-6447.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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